

## **REMARKS**

In response to the above-identified Final Office Action, Applicant amends the application and seeks reconsideration thereof. In this response, Applicant amends claims 1 and 5. Applicant does not cancel any claims or add any new claims. Accordingly, claims 1-3, 5, 7, 21 and 22 are pending.

### **I. Claims Rejected Under 35 U.S.C. § 112, first paragraph**

Claims 5 and 7 stand rejected under 35 U.S.C. §112, first paragraph, because the Examiner asserts that these claims fail to comply with the written description requirement. The Examiner states that he has been unable to find any part of the disclosure which sets forth an average particle size less than 125 microns. The Examiner cites *In Re Lukach* and *In Re Smith* in support of this rejection. Applicant amends claim 5 to claim an average particle size from 34 to 124 microns. This range is explicitly supported in the specification in paragraph 12 in the second to last sentence which describes an embodiment where "the abrasive particles are microcrystals of corundum having an average particle size on the order of 34 microns (μm) to 556μm (320 to 30 grit)."

The Examiner's reliance on *In Re Lukach* and *In Re Smith* are inapposite for the claimed ranged of 34μm to 124μm. *In Re Lukach* discusses a claim to a subgenus range supported by a generic disclosure and a specific example within the range while *In Re Smith* relates to a subgenus claim supported by a genus and species upon which it reads according to the arguments set forth by the Examiner. Applicant does not claim a subgenus or rely on a general genus description. Rather, Applicant claims a discrete range which is inherently supported by an explicit disclosure of a broader range in the specification. See *In Re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (The claimed range of 35% to 60% was upheld as inherently supported by a range of 25% to 60% in the specification). See also MPEP § 2163.05 (II). Thus, the elements of claim 5 and dependent claim 7 are supported by the specification. Accordingly, reconsideration and

withdrawal of the rejection of claims 5 and 7 under 35 U.S.C. § 112, first paragraph, are requested.

## **II. Claims Rejected Under 35 U.S.C. § 102 and 103**

Claims 1-3, 5, 7, 21, 22 stand rejected under 35 U.S.C. § 102(e) or in the alternative under 35 U.S.C. § 103(a) as anticipated or obvious over U.S. Patent No. 6,290,976 issued to Messenger (hereinafter "Messenger").

Messenger is not a valid prior art reference based on the Declaration submitted herewith under 37 C.F.R. § 1.131. Applicant establishes therein that the present invention as claimed in claims 1-3, 5, 7, 21 and 22 was reduced to practice at least as early as the filing date of Messenger April 6, 2000. Therefore, Applicant respectfully requests that the anticipation and obviousness rejection of claims 1-3, 5, 7, 21 and 22 based on Messenger be reconsidered and withdrawn.

Claims 1, 2, 21 and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated or in the alternative under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,294,179 issued to Lee, et al. (hereinafter "Lee").

In regard to claim 1, this claim includes the elements of a base composition comprising at least 20% by weight a moisturizer. The Examiner has not indicated and Applicant has been unable to discern any part of Lee that teaches or suggests a moisturizer that is 20 percent of the base of a composition. Therefore, Lee does not teach or suggest each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the anticipation and obviousness rejection of claim 1 are requested.

In regard to claims 2 and 21, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not anticipated by or obvious over Lee. Further, in regard to claim 21, this claim includes the elements of the composition capable of being left on the skin after application. The Examiner has not identified and Applicant has been unable to discern any part of Lee that teaches or suggests this element of claim 21. Accordingly, reconsideration and withdrawal of the anticipation and obviousness rejection of claims 1, 2, 21 and 22 are requested.

Claims 1-3, 21 and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated or in the alternative under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 3,092,111 issued to Saperstein (hereinafter "Saperstein"), and U.S. Patent No. 4,957,747 issued to Stiefel (hereinafter "Stiefel").

In regard to claim 1, this claim includes the elements of a base of a composition comprising at least 20 percent by weight a moisturizer. The Examiner has not indicated and Applicant has been unable to discern any part of Saperstein or Stiefel that teaches or suggests a base of a composition that is 20 percent by weight a moisturizer. Thus, Saperstein and Stiefel do not teach or suggest each of the elements of claim 1. Accordingly, reconsideration and withdrawal of the anticipation rejection and obviousness rejection of claim 1 are requested.

In regard to claims 2, 3, 21 and 22, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not anticipated by or obvious over Saperstein or Stiefel. Further, in regard to claim 21, this claim includes the elements of a composition capable of being left on the skin after application. The Examiner has not indicated and Applicant has been unable to discern any part of Saperstein or Stiefel that teaches or suggests a composition that can be left on the skin after application. Therefore, Saperstein and Stiefel do not teach or suggest each of the elements of dependent claims 2, 3, 21 and 22. Accordingly, reconsideration and withdrawal of the anticipation and obviousness rejection of claims 2, 3, 21 and 22 are requested.

Claims 1-3, 5, 7, 21 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 4,284,533 issued to Imamura, et al. (hereinafter "Imamura").

In regard to claim 1, this claim includes the elements of a base of a composition comprising at least 20 percent by weight a moisturizer. The Examiner has not indicated and Applicant has been unable to discern any part of Imamura that teaches or suggests a base of a composition having at least 20 percent by weight a moisturizer. Thus, Imamura does not teach or suggest each of the elements of claim 1.

In regard to claims 2 and 3, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 1, these claims are not obvious over Imamura. In regard to claim 21, this claim includes the elements of a composition that may be left on the skin after application. The Examiner has not indicated and Applicant has been unable to discern any part of Imamura that teaches or suggests that the composition of Imamura may be left on the skin after application. Thus, Imamura does not teach or suggest each of the elements of claims 2, 3, 21 and 22. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 2, 3, 21 and 22 are requested.

In regard to claim 5, this claim includes the elements of a base in the form of a cream. Imamura teaches a composition having a viscosity less than 5000 cps. See Imamura, col. 1, lines 53-55. The Examiner argued on page 6 of Paper No. 16 that a viscosity of less than 5000 cps does not appear to teach away from a base in the form of a cream as claimed in claim 5. The Examiner argued that the term cream is not defined in the specification so that a viscosity of less than 5000 cps does not appear to teach away from a cream. However, it is well known to those skilled in the art that a cream has a viscosity significantly higher than 5000 cps. In fact, the Food and Drug Administration when classifying products uses a definition of a cream as having a viscosity greater than 30,000 cps as evidenced by the attached article. See "Topical Drug Bioequivalents: FDA Revised Strategy to be Presented to Committee; Reporting CMC Changes also on Agenda, [www.fdatb.com/fdc/advisorycommittee/committee/pharmaceuticalplusscience/031203\\_topicalderma/031203\\_topicalp.htm](http://www.fdatb.com/fdc/advisorycommittee/committee/pharmaceuticalplusscience/031203_topicalderma/031203_topicalp.htm), March 10, 2003 (Exhibit A). Thus, Imamura does not teach a base composition which is a cream. Therefore, Imamura does not teach or suggest each of the elements of claim 5. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 5 are requested.

In regard to claim 7, this claim depends from independent claim 5 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 5, this claim is not

obvious over Imamura. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 7 are requested.

Claims 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over patent application publication number US 20020090385 applied for by Fox, et al. (hereinafter "Fox").

Fox is not a valid prior art reference based upon the Declaration submitted herewith under 37 C.F.R. § 1.131. Applicant has established that the present invention as claimed was reduced to practicing at least as early as the filing date of Fox, October 5, 2001. Therefore, Applicant respectfully requests that the obviousness rejection of claim 5 be reconsidered and withdrawn.

In regard to claim 7, this claim depends from independent claim 5 and incorporates the limitations thereof. Thus, at least for the reasons mentioned in regard to claim 5, this claim is not obvious over Fox.

### **III. Double Patenting**

The Examiner continues to maintain the provisional double patenting rejection of claims 1-3, 5, 7, 21 and 22 over claims 1-3, and 6-12 of co-pending application number 09/411,712 in view of Lee, Saperstein, Stiefel, or Imamura. Applicant submits herewith a Terminal Disclaimer. Accordingly, reconsideration and withdrawal of the double patenting rejection is requested.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-3, 5, 7, 21 and 22 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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### CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 17, 2003.

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